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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/739,085	12/19/2003	Hiroshi Hagino	246754US	9926
22850 7590 02/07/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER VAKILI, ZOHREH	
			ART UNIT 1614	PAPER NUMBER
			MAIL DATE 02/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	10/739,085	HAGINO ET AL.	
	Examiner	Art Unit	
	Zohreh Vakili	1614	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: 21 and 22.  
Claim(s) rejected: 8-20, 23 and 24.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE: Applicant adds new limitations to the claims that raise the issue of new matter. Further the amendment after final requires further search and consideration since the new limitations were not considered in the previous depending claims. New matter issues are raised when applicant includes limitations in the claims that he/she clearly did not have possession of at the time of invention. Though the examples do not specifically reference a fermentation step, the silence of the disclosure regarding such a step is not sufficient to now claim the exclusion of such a step because nowhere in the disclosure has Applicant discussed the use of fermentation step in the context of the claimed composition.

Continuation of 5. Applicant's reply has overcome the following rejection(s): Rejection of claims 8-24 under 102(b) and 103 over Naoki et al. and the rejection of claims 21 and 22 under 102(b) over Albitskaya and the rejection of claims 8-24 under obviousness-type double patenting over claims 1, 14, 15 and 20 of US Patent No. 6,217,879 are each withdrawn.

Continuation of 11. does NOT place the application in condition for allowance because: The amendment will not be entered into the record because of the addition of the new limitations that have raised new matter issues. Accordingly, Applicant's remarks regarding the obviation of the rejections of record under 102 and 103 in view of the amendments are also not found persuasive, because the proposed after final amendments will not be entered into the record. However, Applicant's remarks regarding the rejection of the claims over Albitskaya have been full considered, but are not persuasive. In particular, Applicant asserts that Albitskaya is directed to the treatment of Chlorella biomass with an organic solvent and then subjecting the complex to hydrolysis via heating and cellulolytic and proteolytic enzymes, and infers that the unhydrolysed Chlorella biomass is insoluble and does not contain hydrophobic or amphiphilic peptides and proteins.

In reponse thereto, it is noted that Applicant is alleging that the biomass and the peptides and proteins are contained within two separate fractions, wherein the biomass is insoluble and the peptides and proteins are soluble. However, these allegations are unsubstantiated by any evidence that such actually is the case and that the hydrolyzed water-soluble fraction is entirely devoid of Chlorella biomass. As stated in MPEP § 716.01(c) [R-2](11), "The arguments of counsel cannot take the place of evidence in the record". Accordingly, the mere assertion that the Chlorella biomass is (1) not water soluble or (2) does not contain the digested proteins or peptides is not persuasive in the absence of any evidence or comparison showing that the product of Albitskaya is substantially different than the claimed product. In fact, in view of Albitskaya's teaching, the claimed product and the disclosed product of the reference are identical. This is supported by the fact that Albitskaya expressly states that the aqueous phase contains protein hydrolysate and Chlorella biomass. Accordingly, the water-soluble extract of Albitskaya is identical to the claimed water-soluble extract, absent factual evidence to the contrary. However, in view of the fact that Albitskaya does not expressly teach the proteases of claims 21-22, the rejection under 102(b) is withdrawn as applied to such claims.

Claims 21-22 are objected to for depending from a rejected base claim.

Applicant's argument regarding the Provisional Double Patenting Rejections have been noted but are maintained due to the absence of Terminal Disclaimer. Applicant's request to hold the provisional double patenting rejections in abeyance is noted. However, in the absence of allowable subject matter or a Terminal Disclaimer, the rejections are properly maintained for the reasons of record set forth in the final rejection of September 13, 2006.

*Ardin H. Marschel* 2/3/07  
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SUPERVISORY PATENT EXAMINER

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